

withdrawal of the rejections of claims 1-9, 15-22, and 43-70 under 35 U.S.C. § 112, second paragraph.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejects claims 1-9, 15-22, and 43-70 under 35 U.S.C. § 103(a) as being unpatentable over Mondet *et al.* (U.S. Patent No. 5,965,116) ("Mondet") for the reasons set forth at pages 2-4 of the Office Action. First, the Examiner contends that "Mondet *et al.* teaches cosmetics compositions comprising copolymers," and "further teaches that the compounds herein termed a first and second organic solvents are also useful in the cosmetic composition." Office Action at 2. Thus, the Examiner asserts, "[a]s discussed in the prior office action, the claimed cosmetic composition, which comprises copolymer and two organic compounds, are obvious over Mondet." Office Action at 2. The Examiner supports this argument by citing old Supreme Court case law holding that, "the selection of a known material based on its suitability for the intended use has been determined to be prima facie obvious. [Citations omitted]." Office Action at 2.

Next, in response to Applicants' previous argument that Mondet provides no motivation to combine the two claimed organic solvents with the claimed polymer, the Examiner argues that "[o]ne of ordinary skill in the art would have been motivated to employ various combination [sic] of the 'plasticizers' list in Mondet *et al.* to optimize the mechanical properties, the cosmetic properties and the adhesion to keratin substance of the deposited film-forming acrylic polymer." Office Action at 3. Mondet states that it can "optionally contain a plasticizer in order to enhance the mechanical properties, the

cosmetic properties and the adhesion to keratin substances of the deposited film-forming acrylic polymer after application and drying," Mondet, col. 4, lines 21-25. According to the Examiner, this passage teaches the instant claimed solvent combination. The Examiner simply restates the argument of record that it is "prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for the same purpose in order to form third composition that is to be used for very the same [sic] purpose." Office Action at 3. The Examiner then incorrectly describes the instant claimed invention as "a combination of two known 'plasticizers'," and concludes that since plasticizers "are known to be beneficial to the film-forming composition, [the combination] sets forth prima facie obvious subject matter." Office Action at 3-4, citing In re Kerkhoven, 205 USPQ 1069 (C.C.P.A. 1980).

Finally, the Examiner misconstrues Applicants' previous argument that Mondet does not provide motivation to use two solvents as claimed. The Examiner inaccurately states Applicants' position to be that because "Mondet et al. teaches that the 'plasticizers' therein is not required, therefore, it is not obvious to employ the 'plasticizers.'" Office Action at 4. The Examiner concludes that "Mondet teaches that the 'plasticizers' are useful for optimizing the performance of the film forming composition. The optimization of a result effective parameter is considered within the skill of the artisan." Office Action at 4.

Applicants respectfully traverse all of the Examiner's arguments for at least the following reasons. As an initial matter, the Examiner has not met his burden of proving a *prima facie* case of obviousness. The Examiner has not shown that motivation exists in Mondet to combine (1) an organic solvent with a molecular weight less than or equal

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to 200 and a boiling point ranging from 100°C to 300°C, (2) an organic solvent with a molecular weight greater than 200 and a boiling point greater than or equal to 120°C, and (3) a polymer as presently claimed. Instead, the Examiner uses only general legal or theoretical arguments in his attempt to establish that the selection of the required solvent would be obvious.

Further, the Examiner appears to be using hindsight in the application of Mondet as a reference, essentially arguing that Mondet could be modified to give the present invention. However, this is not the proper legal standard for obviousness. See In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") As the Federal Circuit has noted, "case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation" of the art. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). Here, Mondet does not suggest the desirability of any modification that would result in the invention as presently claimed.

For example, in the present invention, the coalescing solvent "can be present in the film-forming cosmetic composition according to the invention in an amount sufficient to obtain a film deposited on the keratinic material," and the plasticizer solvent can be present "in a quantity sufficient to plasticize the polymer film deposited on the keratinic material." As-filed application at paragraphs [069] and [073]. In contrast, Mondet states that the compositions it discloses can "optionally contain a plasticizer in order to enhance the mechanical properties, the cosmetic properties and the adhesion to keratin

substances of the deposited film-forming acrylic polymer ***after application and drying.***" Mondet, col. 4, lines 21-25 (emphasis added). Further, according to Mondet, "[t]he presence of a plasticizer is not obligatory in order to adjust the lacquering power" Mondet, col. 4, lines 21-29. In other words, Mondet does not require the plasticizer (solvent) to enhance the film-forming properties, and does not even remotely suggest that choosing at least one of each of two different solvents in combination with a polymer as claimed would provide benefits in forming and applying the film. Thus, the Examiner is forced to use general legal arguments because Mondet does not provide guidance for choosing at least one of each type of solvent as claimed.

The Examiner also argues that it is obvious to combine two solvents known to be solvents, using the rationale of In re Kerkhoven. However, Applicants respectfully argue that the facts of Kerkhoven are not applicable to the present case. In Kerkhoven, the appealed claims were directed to a process for forming a detergent, comprising forming two aqueous slurries, where one slurry was predominantly an anionic detergent and the other was primarily a nonionic detergent, independently or simultaneously drying the slurries, and mixing the resulting products. 205 U.S.P.Q. at 1070. It was acknowledged that prior art detergents comprised a mixture of anionic fatty acid soaps, anionic detergents, and nonionic detergents. Id. To make the known detergents, all of the ingredients were combined together in one slurry and then spray dried. Id. Therefore, the court held that the claims at issue requiring "*no more than the mixing together*" of two conventional detergents to make a third detergent composition set forth "prima facie obvious subject matter." Id. at 1072 (emphasis added).

There are several key differences between the present invention and the invention at issue in Kerkhoven. First, and most importantly, the end product in Kerkhoven was the same as the two combined ingredients: a detergent. In the present invention, the claimed at least two organic solvents, each chosen from a specifically defined group of solvents, and the claimed polymer are combined to create, not a solvent, but a film-forming composition "for making-up or care of keratinic materials such as skin, lips, nails, eyelashes, eyebrows and hair." As-filed Application at paragraph [001]. This film-forming composition end product is *not* itself a solvent nor is it the at least one polymer as claimed; instead it is a combination of the recited ingredients. Thus, the claimed film-forming composition resulting from the combination of the claimed polymer with the claimed solvents requires thoughtful selection of the at least two solvents, depending on the desired end result, as described in the specification.

Moreover, according to M.P.E.P. § 2144.04, "if the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." Applicants in the present case have emphasized the criticality of the two different required solvents in affecting the properties of the film-forming composition. For example, organic solvents with molecular weight less than or equal to 200 are referred to as the "coalescing agent" because it "furthers the coalescence of the particles of polymer in an aqueous dispersion." As-Filed Application at paragraph [067]. Organic solvents with molecular weight greater than 200 are referred to as the "plasticizer" because it "makes it possible to plasticize the at least one polymer in an aqueous dispersion." As-Filed Application at

paragraph [070]. Thus, the present application requires the presence of *at least both* organic solvents and specifically, at least one within each weight range.

For at least the foregoing reasons, Applicants respectfully request that the rejections under 35 U.S.C. § 103 be withdrawn.

V. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to contact Applicant's undersigned counsel at (202) 408-4454.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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